UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/005,199	12/07/2001	Motonori Nakamura	50212-317	8188

20277 7590 12/21/2004

MCDERMOTT WILL & EMERY LLP
600 13TH STREET, N.W.
WASHINGTON, DC 20005-3096

EXAMINER	
HOFFMANN, JOHN M	

ART UNIT	PAPER NUMBER
1731	

DATE MAILED: 12/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No.	Applicant(s)	
	10/005,199	NAKAMURA ET AL.	
	Examiner	Art Unit	
	John Hoffmann	1731	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 13 December 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☒ The proposed amendment(s) will not be entered because:

   (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);

   (b) ☐ they raise the issue of new matter (see Note below);

   (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: *See Continuation Sheet*.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *See Continuation Sheet*.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a)☒ will not be entered or b)☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: _____.

   Claim(s) rejected: *1-9*.

   Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10. ☐ Other: _____

John Hoffmann
Primary Examiner
Art Unit: 1731

12-17-04

Continuation of 2. NOTE: The new issue: what changes are made to the amendment. Claim 1 ,line 9 has "[[a]]" but that "a" was removed in the previous amendment - it was lined through. Thus the present amendment is not in the required format. Examiner has not reviewed the rest of the amendment to tell what else is improper about it - or to see how whether it contains further new issues.

Continuation of 5. does NOT place the application in condition for allowance because: the amendment was not entered. Applicant is correct in that claims 1-5 were examined. That "election/restriction" part of final rejection should be ignored. As to the marking points and dummy rods: Examiner understands that the disclosed invention has two of each, but that is not very relevant because there is no indication that the claims are limited to only the disclosed embodiments. There is no requirement that applicant claim all rods and points - thus the Office does not interpret the claims as necessarily having two rods and two marking points. If applicant wants the claim to be limited to more than one of each - then the claims much clearly indicate such. Presently, if multiple points/rods is claimed, it is vague and unclear for the reasons previously given. As to the argument that a marking point is" virtual" - there is no support for such: applicant cannot now add a defintion to limit what is meant by "marking point". Examiner does not understand how pages 15-17 and/or exhibit B provide for the marking point being a virtual (i.e. not marked) point: there is no explanation. As to the argument that Fujikura does not have a marking point - this is not very relevant because the claims do not require a marking point. (see rejection). Applicant's apparent interprettation does not seem to be reasonable because someone could perform applicant's disclosed process without infringing, simply by just adding another mental/virtual marking point (for a total of three) where the third marking point is nearby (or even on the moon). This third marking point would mean that each marking point is NOT set at a postion as claimed. Clearly, if applicant wants to claim an invention that has two marking points, the claim should clearly state that there are two marking points.